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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,477	12/11/2000	Donald J. Giroux	LC-396 US	5126

7590 07/30/2002

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EXAMINER
GALLAGHER, JOHN J

ART UNIT	PAPER NUMBER
1733	5

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/732477	Applicant(s)	
	Examiner	Group Art Unit	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 1-25 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 1-25 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☑ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☑ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

1. The disclosure is objected to because of the following informalities: Page 23 line 6 - delete either of the words "intermediate" or "between" as being repetitive and redundant one in view of the other.

Appropriate correction is required.

2. Claims 1-25 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Specifically (a) the (first) "wherein" clause in (lines 10-11) of claim 1 can (and should) be deleted as being both incomplete and misplaced; and (b) claim 22 line 1 - replace the word "from" with the term "composed of", AND insert "cured" after "the".

3. Claim 12 contains the trademark/trade name JEFFAMINE. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. § 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the

present case, the trademark/trade name is used to identify/describe an amine type epoxy resin curing agent and, accordingly, the identification/description is indefinite.

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-9 and 11-25 are further rejected under 35 U.S.C. § 103(a) as being unpatentable over Schuft in view of Corley.

Schuft discloses a curable, two-part composition (which finds utility as an adhesive in the bonding of metal and synthetic material substrates) composed of a first epoxy resin containing part (which may also contain a filler) and a second amine-based (e.g. JEFFAMINE) epoxy resin hardener (i.e. curing agent) part, which composition may further contain (a) one or more curing accelerators; and (b) an adhesion promoter; various bonding methods employing this composition are also documented. (Abstract, N.B. column 1 lines 28-37, column 2 lines 60-62, column 3 lines 5-60, column 4 lines 30-41, column 5 line 28 thru

column 6 line 57, column 7 lines 7-16 and 33-35, column 8 lines 1-4 and 19-22).

Corley discloses curable (e.g. two-part) compositions of the type and most similar to those of Schuft (which also find utility as an adhesive in the bonding of e.g. metal, wood, concrete etc. substrate materials) wherein a transition metal (e.g. Zn, Cr etc.) acetylacetonate is employed as the curing accelerator. (Abstract, column 2 line 23 thru column 3 line 32, column 4 lines 32-57, column 5 lines 4-19 and 53-68, column 6 lines 1-42 and N.B. lines 2-4, 25-26 and 39-42), such that it would have been obvious to one of ordinary skill in this art to employ these transition metal accelerators of Corley in/in conjunction with the invention (composition and bonding methods) of Schuft in place of and/or in combination with the corresponding, analogous curing accelerator component provided for and employed therein; mere substitution of one such known curing accelerator for another (and in/from a most similar if not identical environment) involved.

6. Claim 10 is further rejected under 35 U.S.C. § 103(a) as being unpatentable over Schuft in view of Corley and further in view of applicants' admission as to what constitutes prior art (hereinafter referred to as the prior art admission).

The prior art admission (N.B. page 10 line 17 thru page 12 line 7) apparently establishes that the materials or compounds

(termed "adhesion promoters" by applicants envisioned for use and employed by applicants) are both known and known to be employed for this (beneficial) function and result, such that it would have been obvious to one of ordinary skill in this art to employ these materials in this capacity in/in conjunction with the invention of Schuft (as further modified by Corley) in place of the corresponding, analogous adhesive promoter provided for and employed therein; mere substitution of one such known material for another involved. Further along this line, applicants are requested to indicate to and/or supply the Office with full consideration of the closest prior art of which they may be aware which corresponds to this prior art admission.

7. Claims 1-9 and 11-25 are still further rejected under 35 U.S.C. § 103(a) as being unpatentable over either McWhorter or Irving et al., each in view of Schuft and Corley.

McWhorter (Abstract, column 2 line 19 thru column 4 line 18) and Irving et al. (Abstract, column 1 lines 6-8, column 2 lines 4-5 and 65-68, column 3 lines 1-14, column 7 line 60 thru column 11 line 3) both disclose compositions of the type and most similar to those of Schuft and Corley such that it would have been obvious to one of ordinary skill in this art to employ the (a) two-part assembly technique of Schuft (which technique is known to be employed with compositions of this type and under consideration); and (b) transition metal curing accelerator of

Corley (for this its documented beneficial function and result), in/in conjunction with the invention/compositions of either of the two primary references; mere utilization of known techniques and component materials in conjunction with known compositions involved.

8. Claim 10 is still further rejected under 35 U.S.C. § 103(a) as being unpatentable over either McWhorter or Irving et al., each in view of Schuft, Corley and the prior art admission, the reasoning being analogous (i.e. essentially identical) to that set forth at the end of paragraph 6, above.

9. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-25 are yet still further rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of U.S. Patent No.

6,248,204 (to Schuft, applied above) in view of Corley (also applied above). The reasoning is essentially the same as that set forth at the end of paragraph 5, above. This rejection is made on the basis of "different inventive entity, commonly assigned".

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. J. Gallagher whose telephone number is (703) 308-1971. The examiner can normally be reached on M-F from approximately 8:30 A.M. to 5 P.M. The examiner can also be reached on alternate N/A.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for this Group is (703) ~~305-3599.~~ 872-9310

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661/0662.

JJGallagher:cdc
July 25, 2002

JOHN J. GALLAGHER
PRIMARY EXAMINER
ART UNIT 1733